

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent 6,353,038

Allan AHO et al.

Serial Number: 09/446,630

Issued: March 5, 2002

For: NOVEL PLASTIC BASED COMPOSITE AND ITS USE

DECLARATION OF PETER HOLMQVIST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Peter HOLMQVIST, hereby declare as follows:

1. I have read the Petition for Acceptance of Unavoidably Delayed Payment of Maintenance Fee Payment Pursuant to 37 C.F.R. § 1.378(b) filed May 4, 2012 ("Petition"), and the Decision on Petition mailed September 10, 2012 concerning U.S. Patent 6,353,038 ("the '038 patent"). All references to Exhibits in this declaration refer to the exhibits filed as part of the Petition.

My Education, Training and Relevant Experience

2. I earned a degree in Foreign Trade from Handelslaroverket Commercial College in Turku in 1986.

PM

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3. I was trained in U.S. patent maintenance fee law and procedures during my employment from March, 1987 to September, 1995 by Kolster Oy Ab, a Finnish intellectual property law firm ("Kolster"). My training was divided into three areas: domestic (Finnish) patent applications, domestic patents and foreign patents. My training was in-house, on-the-job training and self-study, and specifically included docketing and payment of U.S. maintenance fees.

4. My initial position at Kolster was Office Clerk. I was responsible for docketing of annuity payments for domestic applications. This was subsequently expanded to foreign patents, including U.S. patents. I was promoted to Annuity Department Manager in March, 1989. In this position I was responsible for the docketing, monitoring and payment of both domestic and foreign annuities, including maintenance fees for the U.S. patents of Kolster's clients.

5. While I do not know the exact number, I believe I was responsible for timely payment of annuity fees for approximately 10,000 patents (foreign and domestic) during my employment with Kolster. To the best of my knowledge, no U.S. patent expired due to an erroneous non-payment of a maintenance fee by me during the nine years I was employed by Kolster.

6. Kolster transferred responsibility of all of its annuity payments, including U.S. maintenance fees, to a Swedish annuity payment firm, Patrafee Oy ("Patrafee") in 1995.

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7. I resigned from Kolster to work for Patrafee in September, 1995. My initial position was Country Manager for Finland. I was responsible for all office duties including the entire cycle of annuity docketing, monitoring and payment for both the domestic and foreign patents of Patrafee's Finnish clients.

8. In February, 1998 I was promoted to the position of Key Account Manager for Patrafee's Finnish clients. I was the Patrafee employee who would send Vivoxid its annuity reminders, and otherwise communicate with Vivoxid concerning payment or non-payment of annuity fees for patents and pending applications owned by Vivoxid at the time the second maintenance fee for the '038 patent became due. Mr. Jimmy Lucchesi was the Vivoxid employee I communicated with concerning Vivoxid's maintenance and annuity fee reminders and payments.

9. By September, 2009, the time the '038 patent's second maintenance fee became due, I had over 22 years of experience handling U.S. maintenance payments, and was trained in all aspects of Patrafee's docketing, monitoring and payment procedures. Moreover, my work was supervised and checked for accuracy to ensure no errors were made in the docketing, monitoring and payment of U.S. maintenance fees. More specifically, all database changes regarding docketing, payments, abandonments, etc. were printed on a checklist and compared to the original documents by other competent employees in Patrafee's annuity department.

**The Error Responsible For Non-Payment of
the '038 Patent's Second Maintenance Fee**

10. On information and belief, the deadlines for payment of the '038 patent's maintenance fees were correctly entered into Patrafee's computerized docketing system. The first maintenance fee for the '038 patent was due September 5, 2005. Patrafee timely paid this fee on behalf of Vivoxid on August 12, 2005. See Exhibit B.

11. The second maintenance fee for the '038 patent was due September 5, 2009. Exhibit I is a Patrafee reminder dated March 5, 2009 to Vivoxid which correctly lists the '038 patent, its second maintenance fee due date of September 5, 2009, and Vivoxid's patent family reference "Sulamuovi". Under the terms of the agreement between Patrafee and Vivoxid, Patrafee would pay the '038 patent's second annuity unless specifically instructed by Vivoxid to permit the '038 patent to lapse.

12. Shortly after Exhibit 1 was mailed, Mr. Lucchesi informed me two Vivoxid patent families ("Ti-geeli" and "Lonkkaprotpinnoitus") were to be abandoned, and expressed his concern that Vivoxid would be billed for annuities which were not to be paid. Specifically, he asks how we will handle an invoice which includes a long list of annuities for different patent families, with the invoice due one week away on March 19, 2009. See Exhibit 2, which is an e-mail dated March 12, 2009 from Mr. Lucchesi to me.

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13. In a subsequent e-mail (Exhibit 3), I assured Mr. Lucchesi I could handle this problem, pointing out "the annuities were August cases." I also noted there was only a single annuity due in September, 2009. However, I mistakenly used the wrong Vivoxid reference ("Lonkkaprotpinnoitus" instead of "Sulamuovi") to reference the '038 patent:

"In September only one: US 6353038 Lonkkaprotpinnoitus"

14. I cannot recall or explain why I used the wrong Vivoxid patent family code with the '038 patent in Exhibit 3. One possible reason why my mistake was not caught by Patrafee's internal controls and procedures is because the mistake was in an e-mail rather than an erroneous docketing entry. Patrafee's rigorous internal controls are designed to ensure maintenance fee payment dates are correctly entered into its docketing system, and that the client's payment/nonpayment instructions are faithfully followed.

15. Mr. Lucchesi instructed me to abandon the '038 patent in an e-mail dated June 5, 2009 (Exhibit 4). Mr. Lucchesi's e-mail does not include the '038 patent number and instead simply refers to "that September payment".

16. I informed Patrafee's main address, info@patrafee.com, for which Ms. Maj-Len Bussman, an IP Administrator in Patrafee's Patent Annuities and Renewals Department was responsible that specific day, that the '038 patent was to be permitted to lapse. See Exhibit 5.

**Patrafee's Business Routine to Prevent Errors
In the Non-Payment of Maintenance Fees**

17. Patrafee had established standard procedures to ensure a patent would not lapse due to an erroneous non-payment of a maintenance fee. First, Patrafee will automatically pay the maintenance fee in the absence of specific, express instructions not to pay the maintenance fee and instead permit the patent to lapse. Second, when a client instructed Patrafee not to pay a maintenance fee, Patrafee would send a confirmation letter prior to the abandonment. The confirmation letter is addressed to the client, identifies the specific patent by number and client reference, states that Patrafee has received instructions and confirms the patent will be allowed to lapse. The confirmation letter also recites the date the patent will lapse.

18. In my opinion and experience, these standard procedures constitute a business routine which can reasonably be relied upon to avoid errors in the payment and non-payment of maintenance fees.

19. Patrafee's standard procedures for abandoning a client's patent were followed in the case of the '038 patent. Thus, Patrafee mailed a letter correctly identifying the '038 patent by number and also by its "Sulamuovi" reference to Mr. Lucchesi (Exhibit 6) which confirmed his instructions to permit the '038 patent to lapse by non-payment of the annuity. Exhibit 6 correctly states the annuity (second maintenance fee) falls due on September 5, 2009, and that the '038

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patent would lapse on March 5, 2010. Exhibit 6 closes by requesting Mr. Lucchesi to check his records to ensure Patrafee understood his instructions correctly.

20. On information and belief, Vivoxid either did not receive or misplaced Exhibit 6.

21. On information and belief, Patrafee did not receive any response to Exhibit 6. Accordingly, the '038 patent was removed from Patrafee's computer records, and permitted to lapse by non-payment of its second maintenance fee.

22. In my opinion, the underlying cause of the non-payment of the second maintenance fee is the miscommunication between myself and Mr. Lucchesi due to my erroneous use of the wrong Vivoxid patent family code for the '038 patent in Exhibit 3, and Mr. Lucchesi's failure to catch the error when he instructed me to abandon the '038 patent.

23. In my opinion, a second cause of the non-payment of the second maintenance fee is Vivoxid's non-receipt or misplacement of Patrafee's confirmation letter (Exhibit 6).

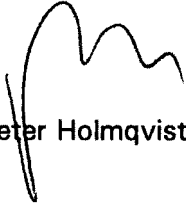
24. To the best of my knowledge, no other U.S. patent has expired due to erroneous non-payment of a maintenance fee as a result of an error by me during my employment by Patrafee.

25. All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. These

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statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the '038 patent.

Signed this 31 day of October, 2012.



Peter Holmqvist